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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/921,733	08/03/2001	Michael Thomas Aarons	ALAMM.002A	8757

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EXAMINER

NGUYEN, MINH DIEU T

ART UNIT PAPER NUMBER

2137

DATE MAILED: 07/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/921,733

Applicant(s)

AARONS, MICHAEL THOMAS

Examiner

Minh Dieu Nguyen

Art Unit

2137

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 August 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>See attached</u> . | 6) <input type="checkbox"/> Other: _____ |

Information Disclosure Statement(s)

February 11, 2002

March 12, 2002

August 13, 2002

April 15, 2003

October 21, 2003

DETAILED ACTION

1. Claims 1-20 are pending.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-5 and 7-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. Claim 1 provides for "the use of an optical disc" and "the use of signing legal and financial transactions". Since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

b. Claim 2 provides for the use of the storage of a digital signature or digital certificate on a CD-ROM, CD-R, CD-RW or DVD and the use of making the digital signature portable for use on several different computers. Since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

c. Claims 3-5 and 7-20 are rejected with the same rationales as addressed above claims 1-2.

4. Claim 6 recites the limitation "***The*** method of incorporating ***the*** date as part of ***the*** encryption key for protecting ***the*** digital signature. The date is added as a portion of ***the*** password ". There is insufficient antecedent basis for this limitation in the claim (bold and italic for emphasis).

This is just one of the example of claimed limitation lacks antecedent basis, please check the rest of the claims in the application.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-5 and 7-20 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd. App. 1967) and *Clinical Products, Ltd. V. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-5, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Herzberg et al. (5,745,678).

a) As to claims 1 and 3, Herzberg discloses an optical disc (i.e. Compact Disc) contains an embedded and encrypted digital signature for use of signing legal and financial transactions over a network (Fig. 3; col. 8, lines 40-67).

b) As to claim 2, Herzberg discloses an optical disc with an embedded digital signature, it is inherently understood that optical disc is portable, therefore the digital signature is portable for use on several different computers.

c) As to claims 4-5, Herzberg discloses an optical disc with embedded digital signature, it is inherently understood that optical disc could store more than one digital signature for the security reason, in the case that one is compromised.

8. Claims 6, 10-11, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Davies (4,799,258).

a) As to claim 6, Davies discloses apparatus and method for granting access to computers comprising incorporating the date as part of an encryption key for protecting digital signature (Fig. 2).

b) As to claim 10-11, Davies discloses a distinctive message (i.e. password) can be combined for enciphering before digital signature is generated (col. 6, line 64 to col. 7, line 2).

9. Claims 7-9, as best understood, are rejected under 35 U.S.C. 102(e) as being anticipated by Graunke et al. (6,105,137).

Graunke discloses method and apparatus for integrity verification, authentication and secure linkage of software modules, each software module initially establishes its own credentials, then the local software module ensures its integrity by validating its own digital signature (col. 1, lines 45-55).

10. Claims 12-14, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Rusnak et al. (6,098,056).

The digital signature has been place on the electronic document (Fig. 2) and the public key is provided along with the document for verification the authenticity of a document that was guarded through the use of a private key (col. 3, lines 8-47).

11. Claims 15-18 and 20, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Muftic (5,943,423).

Muftic discloses method of creating and verifying digital signatures on electronic documents and transactions (i.e. payroll, personal checks, funds transferred; col. 4, lines 11-67; col. 5, lines 1-22).

12. Claim 19, as best understood, is rejected under 35 U.S.C. 102(e) as being anticipated by Tello (6,463,537).

Tello discloses the use of digital signature as a key to access personal computers and allow computer's BIOS to access to ensure the proper use (Abstract).

13. An examination of this application reveals that applicant is unfamiliar with patent prosecution procedure. While an inventor may prosecute the application, lack of skill in this field usually acts as a liability in affording the maximum protection for the invention disclosed. Applicant is advised to secure the services of a registered patent attorney or agent to prosecute the application, since the value of a patent is largely dependent upon skilled preparation and prosecution. The Office cannot aid in selecting an attorney or agent.

A listing of registered patent attorneys and agents is available on the USPTO Internet web site <http://www.uspto.gov> in the Site Index under "Attorney and Agent Roster." Applicants may also obtain a list of registered patent attorneys and agents located in their area by writing to the Mail Stop OED, Director of the U. S. Patent and Trademark Office, PO Box 1450, Alexandria, VA 22313-1450

Conclusion

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minh Dieu Nguyen whose telephone number is 571-272-3873. The examiner can normally be reached on M-F 6:00-2:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on 571-272-3865. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-2100.


mdn
6/22/05

Minh Dieu Nguyen
Examiner
Art Unit 2137


AYAZ SHEIKH
SUPERVISORY PATENT EXAMINER
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